

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Title: "System and Method for Dynamically Routing an Object
Through an Organization's Workflow System"

Appellants: Tejaswini Hosalli, et al.

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Board of Patent Appeals and Interferences
Commissioner for Patents
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SUPPLEMENTAL APPEAL BRIEF

Dear Sir:

This supplemental Appeal Brief is submitted in response to the
Notification of Non-Compliant Appeal Brief of March 19, 2009.

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(1) Real Party in Interest

The real party in interest is International Business Machines Corporation.

(2) Related Appeals and Interferences

No other appeals or interferences exist that relate to the present application or appeal.

(3) Status of Claims

Claims 1-4, 8-9, 11-12, and 23-24 are being appealed. Claims 13 - 22 have been canceled without prejudice in the Amendment After Appeal under 37 CFR 41.33.

Claims 1-4, 8-9, 11-15, 19-20, and 22-24 were rejected under 35 U.S.C. 102(e) as being anticipated by Bacon et al. (U.S. Patent No. 6430538), hereinafter referred to as "Bacon".

Claims 5-7, 10, 16-18, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon.

(4) Status of Amendments

Amendment After Appeal under 37 CFR 41.33 is currently pending.

(5) Summary of Claimed Subject Matter

5.1. Problem addressed by the present invention

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to address the problem addressed by the present invention, in order to place the invention in its proper context.

A Systems Applications and Products (SAP) workflow provides the infrastructure and tools that enable business processes and human resources management more efficiently. It routes data quickly to the proper individual, even if the person is in a different office or country, and facilitates the administrators' task of dealing with transactions and forwarding them through the chain of command.

The SAP workflow enables business processes to be defined according to organizational standards and organization-specific procedures. The workflow may be monitored and information on the current status of a task or work item may be viewed at any time. Work load distribution and identifying capacity problems or work overload can be identified before developing into a problem. **With the SAP workflow, administrators can approve transactions, even partially, in a uniform process.**

However, prior to the advent of the present invention, there was an unsatisfied need for a system and a method that improve the performance of SAP workflows, and that cause changes made to the

organization to be **automatically** reflected in the workflow, **without the administrators' interference**, by efficiently routing the corresponding object through the organization's workflow system. *(Reference is made to page 1, line 13 - page 2, line 2).* For example, **whenever changes are made to an organization, they are automatically reflected in the workflow**. *(Reference is made to page 2, lines 8-11).*

5.2. Summary of the subject matter of independent claim 1

The present invention is exemplified by independent claim 1, according to which a processor-implemented method, system, and computer program product route an object through a workflow system *(Reference is made to page 6, lines 4-6).*

More specifically, and with further reference to FIGS. 1 and 2 of the instant application, the present invention parses the object into portions that are likely to follow different workflow paths. *(Reference is made to page 2, lines 25-30).*

The present invention examines information and an organizational structure contained in each parsed portion. *(Reference is made to page 3, lines 1-11).*

Based on examined information and organizational structure, the present invention determines an appropriate destination for the object at a lowest possible granularity level within the organizational structure *(reference is made to page 3, lines 13-28, and page 2, lines 16-20)*, in order to route the object to the appropriate destination *(reference is made to step 125 of FIG. 2, and to page 8, lines 3-4).*

5.3. Summary of the subject matter of independent claim 12

While claim 1 exemplifies the present invention in connection with a method for routing an object through a workflow system, claim 12 generally corresponds to claim 1, and exemplifies the present invention in connection with a computer program product for routing an object through a workflow system.

The computer program product of the present invention includes a set of instruction codes that implement the steps of the method of FIG. 2, as described above in connection with the summary of claim 1. Reference is made to page 6, lines 4-9 that associates the computer program product with the method and system of the present invention.

More specifically, and with further reference to FIGS. 1 and 2 of the instant application, the present invention includes a set of instruction codes for parsing the object into portions that are likely to follow different workflow paths. *(Reference is made to page 2, lines 25-30).*

The present invention further includes a set of instruction codes for examining information and an organizational structure contained in each parsed portion. *(Reference is made to page 3, lines 1-11).*

Based on examined information and organizational structure, a set of instruction codes of the present invention determines an appropriate destination for the object at a lowest possible granularity level within the organizational structure *(reference is made to page 3, lines 13-28, and*

page 2, lines 16-20), in order to route the object to the appropriate destination (reference is made to step 125 of FIG. 2, and to page 8, lines 3-4).

5.4. Summary of the subject matter of independent claim 23

While claim 1 exemplifies the present invention in connection with a method for routing an object through a workflow system, claim 23 generally corresponds to claim 1, and exemplifies the present invention in connection with a system for routing an object through a workflow system.

The system 10 (FIG. 1) of the present invention includes means for implementing the steps of the method of FIG. 2, as described above in connection with the summary of claim 1. Reference is made to page 6, lines 4-9 that associates the computer program product with the method and system of the present invention.

More specifically, the present invention includes means for parsing the object into portions that are likely to follow different workflow paths. (Reference is made to page 2, lines 25-30).

The present invention further includes means for examining information and an organizational structure contained in each parsed portion. (Reference is made to page 3, lines 1-11).

Based on examined information and organizational structure, a means determines an appropriate destination for the object at a lowest possible granularity level within the organizational structure (reference is made to

page 3, lines 13-28, and page 2, lines 16-20), in order to route the object to the appropriate destination (reference is made to step 125 of FIG. 2, and to page 8, lines 3-4).

(6) Grounds of Rejection to be Reviewed on Appeal

Appellants respectfully traverse the following grounds of rejection of the claims on appeal, and respectfully request these grounds of rejection be reviewed on appeal:

Claims 1-4, 8-9, 11-12, and 23-24 were rejected under 35 U.S.C. 102(e) as being anticipated by Bacon.

Claims 5-7 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon.

(7) Arguments

7.A. Arguments Responding to the First Ground of Rejection

7.A.1. The Rejection

Claims 1-4, 8-9, 11-12, and 23-24 were rejected under 35 U.S.C. 102(e) as being anticipated by Bacon. In response, Appellants respectfully traverse this rejection, and submit that Bacon does not disclose all the elements and limitations of the claims on file. Consequently, the present claims are not anticipated under 35 U.S.C. 102, and the allowance of these claims is earnestly solicited.

7.A.2. Legal Standard for Lack of Novelty (Anticipation)

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Appellants' position of non anticipation:

- "Anticipation under Section 102 can be found only if a reference shows exactly what is claimed; where there are differences between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
- "Absence from a cited reference of any element of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

7.A.3. Application of the Anticipation Standard to the Present Invention

Appellants wish to emphasize the strict application and interpretation of the anticipation legal standards. Accordingly, all that the Appellants are required to prove, in order to satisfy the novelty requirement, is the existence of a single novel feature in the claims.

To this end, Appellants will now focus their analysis on representative claim 1. With reference to claim 1, the Examiner indicates that Bacon discloses "based on examined information and organizational structure,

determining an appropriate destination for the object at a lowest possible granularity level within the organizational structure (see column 4 lines 38-65 see column 10 lines 10-54 and figure 7; where the server identifies the next activity based on the business process and the just completed activity and pushes the object to the next necessary destination."

Appellants respectfully submit that Bacon describes assigning personal subworkflows to given participants, work group, or other workflow entities. However, Bacon does not include the methodology of determining the lowest possible granularity sub-group to assign the subflow / activity.

The present invention meets the need for the routing requirement of an object through an organization's workflow system. To this end, the system and associated method of the present invention can utilize, for example, the Systems Applications and Products (SAP) workflow technology so that whenever changes are made to an organization, they are automatically reflected in the workflow.

Since the SAP workflow is position-based, rather than person-based, the workflow routes do not need to be updated every time an employee is promoted or changes jobs, thus increasing the efficiency of the organization's sales, purchasing, and human resources, by implementing a single routing structure for all processes, across all applications, throughout the organization, worldwide. The ability to have an open, flexible routing method that reaches a low level of granularity within an organization or organizations improves productivity by sending the work items to specific recipients, and further improves the system and network performance by

selectively sending only work items to those specific recipients as opposed to large groups of people.

In response to this argument, the Examiner indicates that: "Bacon explicitly teaches "based on examined information and organizational structure, determining an appropriate destination for the object at a lowest possible granularity level within the organizational structure" (**see column 4 lines 38-65, column 10 lines 10-54, and figure 7**; where the server identifies the next activity based on the business process and the just completed activity and pushes the object to the next necessary destination. The server uses process definitions in order to determine the most appropriate destination of the object. The process definitions contain logic that enables the system to isolate the appropriate destination. **This use of process definitions and decision agents to route objects is the same as determining the lowest level of granularity to route an object to.**).

Emphasis added.

Appellants have reproduced below, the excerpt cited by the Examiner, Bacon column 4 lines 38-65, for the convenience of reference:

"The server 110 effectively interprets the process definition 107 and cooperates with the clients 130 and agents 120 to schedule the sequence of the various process definition-specified activities. More specifically, the server 110 may include one or more engines 115, in which each engine individually or with a co-operating engine schedules the sequence of activities of a given process 107 with the cooperation of an agent 120 or client 130. Moreover, each engine 115 together with cooperating agents and clients makes scheduling decisions from considering (1) the definition 107, (2) status information from agents 120 and clients 130 (e.g., completion status of an activity), and (3) other external and/or internal events. Upon determining that an activity may be started, the engine 115 routes a

given work item 117 to the appropriate actors, such as agents 120, clients 130, or possibly a work group (not shown) where an activity is performed. For certain types of activity interrelationships, the engine 115 may clone a work item 117 and route cloned work items to several actors.

Agent 120 is a software entity responsible for autonomously implementing a given activity. By "autonomous" it is meant that no human action is needed in performing this activity. The process definition 107 may identify or reference a given agent 120a to indicate which software entity is responsible for performing a given activity within the process definition 107. Each agent 120 receives and sends work items 117."

Appellants respectfully traverse this rejection ground and submit that **nowhere do the texts and figure** (Bacon, column 4 lines 38-65, column 10 lines 10-54, and figure 7) that are referenced by the Examiner, **refer to the determination of the lowest level of granularity**. Actually, the term "granularity" is not mentioned in the entire Bacon patent. It is not clear to Appellants how the Examiner analogized or equated the concept of identifying the next activity with determining the lowest level of granularity.

Furthermore, the Examiner rejects claim 2 on the ground that: "The method of claim 1, further including examining external information, if any, related to each parsed portion, to further determine the lowest possible granularity level of the object destination (see column 4 lines 39-57; where external activities are examined to determine the status of the workflow and the next possible activity.)."

Appellants have reproduced below, the excerpt cited by the Examiner, Bacon, column 10 lines 10-54, for the convenience of reference:

"In step 730 the server obtains the work item just sent to it as a result of activating the user control and forwards the work item to a decision point agent.

In step 735 the decision point agent uses the work item to determine which branch expression corresponds to the work item. This is possible because the work items are identified with a naming convention that identifies a given stage of completion of the work item within a workflow, and thus the decision point agent may map the name to a branch expression associated with the current activity.

In step 740 the decision point agent parses the expression in view of the work item contents and provides a true or false conclusion to the server.

In step 745 the server uses the true or false conclusion and interprets the work flow definition to determine which subsequent activity corresponds to a true conclusion and which corresponds to a false conclusion.

Based on the server's determination, the server in step 750 schedules a subsequent activity by identifying a corresponding work item and corresponding HTML display, if any. If the subsequent activity is another activity within the defined personal subflow the logic branches back to step 720, which will cause the logic to be repeated but will cause the loading of the newly-associated HTML page to be displayed in the open browser window frame. If the subsequent activity is not within the personal subflow, the personal subflow ends in step 799.

Under a preferred embodiment, the controls associated with a personal subflow are extended to include a "next" and a "back" control to navigate, respectively, to a subsequent activity of the personal subflow, or to a previous activity of the personal subflow. Under one embodiment of the invention, the "next" control causes the logic flow described above, i.e., evaluating of a branch expression to determine the specific activity to perform next, and the "back" control may be used to "roll-back" the update of a work item operation. ("Roll-backs" are known in the field of transaction processing.) Alternatively, the next and back controls may be used

to update the work item contents and such information would then be used by the decision point agent in its branch expression."

Appellants respectfully submit that Bacon discloses determining the status of the workflow and the next possible activity. It states that "the engine 115 routes a given work item 117 to the appropriate actors, such as agents 120, ...". However, **Bacon does not examine or determine the lowest possible granularity level of the object destination.**

Consequently, based on the strict legal requirements of the anticipation standard, claim 1 is not anticipated by Bacon. As a result, claim 1 and the claims dependent thereon are allowable. In addition, independent claims 12 and 23 are allowable for containing a similar subject matter to that of claim 1. Therefore, claims 12 and 23 and the claims dependent thereon, are also allowable.

7.B. Arguments Responding to the Second Ground of Rejection

7.B.1. The Rejection

Claims 5-7 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon. In response, Appellants respectfully traverse these rejections, and submit that Bacon does not disclose all the elements and limitations of the claimed invention, as a whole. Consequently, the claims on file are not obvious in view of the cited reference, and the allowance of these claims is earnestly solicited. In support of this position, Appellants submit the following arguments:

7.B.2. Legal Standard of Obviousness

Appellants submit the following legal authorities for inclusion in the records. These legal authorities set the general legal standards in support of Appellants' position of non obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), **"To establish a prima facie case of obviousness, three basic criteria must be met.** First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ... The initial burden is on the examiner to provide some **suggestion of the desirability** of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the **references must expressly or impliedly suggest the claimed invention** or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."
- **In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is** not whether the differences themselves would have been obvious, but **whether the claimed invention as a whole would have been obvious.** The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).

- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art**. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "**All words in a claim must be considered** in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.**). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." **Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317

(Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

- "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).
- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F. 3d 994 (Fed. Cir. 1999).
- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).

- "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." See KSR, 82 USPQ2d 1397.
- The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

7.B.3. Argument

Appellants respectfully submit that claims 5-7 and 10 are allowable for depending on the allowable independent claim 1, as presented earlier.

Respectfully submitted,

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APPENDIX A
CLAIMS ON APPEAL

1. A processor-implemented method of routing an object through a workflow system, comprising:
 - parsing the object into portions that are likely to follow different workflow paths;
 - examining information and an organizational structure contained in each parsed portion;
 - based on examined information and organizational structure, determining an appropriate destination for the object at a lowest possible granularity level within the organizational structure; and
 - routing the object to the appropriate destination.
2. The method of claim 1, further including examining external information, if any, related to each parsed portion, to further determine the lowest possible granularity level of the object destination.
3. The method of claim 2, further including examining a set of business rules, if any, contained in each parsed portion and related to the organizational structure, to further determine the lowest possible granularity level of the object destination.
4. The method of claim 3, wherein parsing the object into portions includes parsing the object into subsets of information.
5. The method of claim 3, wherein the subsets of information include

customer information.

6. The method of claim 3, wherein the subsets of information include customer credit information.

7. The method of claim 3, wherein the subsets of information include country information.

8. The method of claim 3, wherein the object includes an intermediate document.

9. The method of claim 3, wherein the object includes a transactional document.

10. The method of claim 3, wherein the organization structure includes an organizational hierarchy.

11. The method of claim 3, wherein the set of business rules includes specific routing rules.

12. A computer program product having executable codes stored on a computer-usable medium for routing an object through a workflow system, comprising:

a first set of instructions for parsing the object into portions that are likely to follow different workflow paths;

a second set of instructions for examining information and an organizational structure contained in each parsed portion;

a third set of instructions for determining an appropriate destination for the object at a lowest possible granularity level within the organizational structure, based on examined information and organizational structure; and

a fourth set of instruction codes for routing the object to the appropriate destination.

23. A processor-implemented system for routing an object through a workflow system, comprising:

means for parsing the object into portions that are likely to follow different workflow paths;

means for examining information and an organizational structure contained in each parsed portion; and

means for determining an appropriate destination for the object at a lowest possible granularity level within the organizational structure, based on the information and the organizational structure; and

means for routing the object to the appropriate destination.

24. The system of claim 23, wherein the examining means includes instructions for examining external information and a set of business rules related to each parsed portion, to further determine the lowest possible granularity level of the object destination.

APPENDIX B
EVIDENCE

None

APPENDIX C

RELATED PROCEEDINGS

None